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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

555255012558

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on Oct. 7, 2007Signature Debra PeteanTyped or printed name DEBRA PETEAN

Application Number

10/788,870

Filed

2/27/04

First Named Inventor

Vadim Fux

Art Unit

2178

Examiner

Manglesh M. Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

 Registration number if acting under 37 CFR 1.34 47,906
Mitchell Rose

Signature

Mitchell Rose

Typed or printed name

216-586-7094

Telephone number

10/2/07

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Fux et al
Title	:	Font Data Processing System and Method
Application No.	:	10/788,870
Confirmation No.	:	7232
Filing Date	:	2/27/04
Examiner	:	Manglesh M. Patel
Group Art Unit	:	2178
Attorney Docket	:	555255012558

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Prior to filing an Appeal Brief, Applicants request review of the rejections set forth in the final Office Action mailed July 2, 2007. As explained below, these rejections have clear errors, thus failing to make a *prima facie* case of unpatentability.

Any fees due should be charged to Jones Day's Deposit Account No. 501432, reference 555255012558.

REMARKS

I. The Rejection of Independent Claims 1, 10, 18 and 19 Should Be Withdrawn

The rejection of independent claims 1, 10, 18 and 19 over Mori is in error, because the Office Action fails to make a *prima facie* case for rejection under 35 USC 103(a). This is based on each of these claims reciting two limitations not suggested by Mori. They are A) storing a client's font capabilities list; and B) comparing the client's font capabilities to font data of an electronic data transfer. These limitations are explained individually as follows:

A. Mori fails to suggest the limitation of STORING a client font capabilities list

Each of the claims recites a limitation of storing (or "determining" in claim 19) a list of client font capabilities. This is exemplified by a server configured to forward data transfers (e.g., electronic documents) to any number of client computers that the server serves. The system stores (or determines), for each client device individually, a list of fonts that the device is capable of rendering.

The Examiner acknowledges that this limitation, of a system storing or determining a font capabilities list for each client, is **not** taught by Mori:

"Mori doesn't explicitly define what client device supports what font within the library of fonts." (Office Action, p. 2)

The Examiner makes up for this deficiency with the following assumption:

"However, at the time of the invention it would have been obvious to one of the ordinary skill to include a listing of fonts with the appropriate device tat supports them. The motivation for doing so would have been to allow display of rich-styled text based on the device capabilities thereby reducing the computational requirements of the client device." (Office Action, p. 11, 1st par.).

This assumption by the Examiner is not supported by any prior art and is thus irrelevant to obviousness. "To establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*" (MPEP 2143.03). Since the Office Action fails to meet this burden, the rejection must be withdrawn.

This is in addition to the Examiner's assumption being unreasonable. That is because the skilled person would have been dissuaded from implementing the claimed limitation of storing each of the clients' font capabilities due to the increased procedural complexity and hardware demands that would be required, especially in the absence of any suggestion from the prior art to do so.

B. Mori fails to suggest the limitation of COMPARING the client font capabilities to font data of an electronic data transfer

Each of the claims recites a limitation of comparing the client's font capabilities to font data of an electronic transfer that is addressed to the client, to determine augment font data to be included with the data transfer to the client. This is exemplified by a server forwarding, to a client computer, an electronic document ("data transfer") that designates a set of fonts by which the document's text is to be rendered. The system compares the fonts designated in the document with the fonts that the client is capable of supporting, in order to determine which additional fonts ("augment font data") the system needs to send along with the document to the client.

This limitation of comparing is not suggested Mori. In fact, Mori's system is **incapable** of performing this limitation, since it does not even **have** the client's font capabilities list (as the Examiner acknowledges in the first block quote above) with which to compare.

In conclusion, Mori fails to suggest both the storing limitation AND the comparing limitation. The rejection of claims 1, 10, 18 and 19 is therefore in error and should be withdrawn.

II. The Rejection of Independent Claim 24 Should Be Withdrawn

The rejection of independent claim 24 over Chan in view of Mori is in error and should be withdrawn. That is because the references, even in combination, fail to suggest the claimed steps of A) storing a font capabilities list for each client device; and B) comparing the fonts in the capabilities list of one of the devices with font identifiers in text data. These limitations are explained individually as follows:

A. The references fail to suggest the claimed STORING of a client capabilities list

Claim 24 recites a method step, performed by a server, of storing a font capabilities list for each of its client devices. This is a list of fonts for which the respective client device has font structure data defining how the font is to be rendered.

In contrast, Chan's server does NOT store a font capabilities list for its client devices. The Examiner contends this storing limitation is taught by the statement in Chan's abstract that "The font server contains the necessary information pertaining to the various types of fonts that may be required by users." However, this sentence in Chan does not refer to the claimed list of a client's font capabilities. It instead refers to the server's own library of fonts that it downloads to users, as indicated by Chan's statement several lines down that "the necessary font resources are downloaded from the font server to the remote site."

Mori, also, does not teach the claimed storing step, as the Examiner acknowledges in the first block quote above.

Therefore, the references even in combination fail to suggest the claimed storing step.

B. The references fail to suggest the claimed COMPARING of fonts in a client's capabilities list with font identifiers in text data

Claim 24 recites a method step, performed by a server, of comparing the fonts in the capabilities list of one of the client devices with font identifiers in text data to be transferred to that device.

In contrast, Chan's server never compares a client device's font capabilities with the fonts of transferred text data. Instead, Chan's client device ("remote site") itself does the comparing, as the Office Action (p. 7, 2nd line) acknowledges: "the **remote site** determines whether information pertaining to all the fonts is stored at the remote site."

Mori, also, does not teach the claimed comparing step, as explained above regarding the rejection to claims 1, 10, 18 and 19.

In conclusion, the references even in combination fail to suggest both the claimed storing step AND the claimed comparing step. The rejection of claim 24 is therefore in error and must be withdrawn.

III. The Rejection of Dependent Claims 2-9, 11-17, 20-21 and 25-28 Should Be Withdrawn

The remaining claims all depend from base claims that are non-obvious over the cited prior art as explained above. The limitations that the dependent claims add to the base claims distinguish them further from the prior art. Therefore, the rejections of the dependent claims also should be withdrawn.

Respectfully submitted,

Mitchell Rose

Mitchell Rose (Reg. No. 47,906)
JONES DAY
901 Lakeside Ave.
Cleveland, OH 44114
(216)586-7094

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